REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1, 2, 8, 10, 11, 13-17, 23, 24, 30, 32, 33, 35-39, 45-48, 50-52, and 54 are currently pending, with Claim 54 being withdrawn as directed to a non-elected invention. Claims 1 and 23 have been amended by the present amendment. The changes to the claims are supported by the originally filed specification and do not add new matter.

In the outstanding Office Action, the claims were subjected to a restriction requirement; Claims 1 and 23 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement; Claims 1, 2, 8, 10, 13-15, 23, 24, 32, 35, 36, 37, 45, 46, 48, 51, and 52 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,219,694 to Lazaridis et al. (hereinafter "the '694 patent") in view of U.S. Patent No. 6,246,485 to Brown et al. (hereinafter "the '485 patent"); Claims 11, 16, 17, 30, 33, 38, and 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the '694 and '485 patents, further in view of U.S. Patent No. 5,951,636 to Zerber (hereinafter "the '636 patent"); and Claim 47 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the '694 and '485 patents, further in view of U.S. Patent No. 6,108,492 to Miyachi (hereinafter "the '492 patent").

Applicants wish to thank the Examiner for the interview granted Applicants' representation on March 19, 2008, at which time a proposed amendment to the claims was discussed. At the conclusion of the interview, the Examiner indicated that the proposed amendment would likely overcome the outstanding rejection of the claims.

In response to the Restriction Requirement, Applicant elects Claims 1, 2, 8, 10-11, 13-17, 23, 24, 30, 32, 35-38, 45-48, and 50-52 belonging to Group I.

10

Amended Claim 1 is directed to a method of processing messages, comprising: (1) receiving an electronic mail message by a computer; (2) <u>determining, by the computer, which of the following mutually exclusive conditions is true: (a) a content of the received message is intended to be read or viewed by a user, and (b) the content of the received message provides instruction codes to an attached printing device associated with the computer, by detecting a predetermined code in a body or a subject line of the message</u>, wherein the instruction to the attached printing device relates to monitoring or control of the attached printing device, the attached printing device including a processor; (3) transmitting a communication including the instruction codes from the computer to the attached printing device through a device driver component of the computer <u>without displaying the received message to the user</u>, if the determining step detects the predetermined code indicating that the content of the received message provides the instruction codes to the attached printing device; and (4) operating the processor of the attached printing device in response to the transmitted communication. The changes to Claim 1 are supported by the originally filed specification and do not add new matter.[1]

Applicant respectfully submits that the rejection of Claims 1 and 23 under 35 U.S.C. § 112, first paragraph, are rendered moot by the present amendment to those claims. Claims 1 and 23 have been amended to no longer recite that the content of the received message does not include print data to be printed by the attached printing device and the instruction to the attached printing device is unrelated to printing of the data included in or attached to the received message. Applicant respectfully submits that this limitation is supported by the originally filed specification and drawings, but in the interest of forwarding prosecution, Applicant has amended this limitation.

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[1] See Figure 14 and the discussion related thereto in the specification in particular page 27, lines 13-20.

Regarding the rejection of Claim 1 under 35 U.S.C. § 103(a), the Office Action asserts that the '694 patent discloses everything in Claim 1 with the exception that the attached printing device including a processor, and relies on the '485 patent to remedy that deficiency.

Applicant respectfully submits that rejection of Claim 1 (and all similarly rejected dependent claims) is rendered moot by the present amendment to Claim 1.

The '694 patent is directed to a system and method for pushing information from a host system to a mobile communication device having a shared electronic address with the host system. As shown in Figure 1, the '694 patent discloses a system in which certain user-defined trigger events are activated and messages are redirected from a desktop computer to a mobile communication device. In particular, as shown in steps 68-72 of Figure 4, regarding incoming e-mail messages, if the messages are to be redirected by the redirector 12, the message is repackaged by placing an outer wrapper around the original message before being forwarded to the user. Further, the '694 patent discloses that if the redirector is configured so that the mobile data device can not receive and process word processor or voice attachments, then the redirector routes those attachments to an external machine that is compatible with a particular attachment, such as a printer, network fax machine, or telephone.[2] However, Applicant notes that the '694 patent discloses that all of the e-mail messages that are redirected by the redirection software 12 are intended to be read or viewed by a user, even if some of the attachments are first printed by a printer before being viewed by a user.

Moreover, Applicant respectfully submits that the '694 patent fails to disclose the step of determining, by a computer, which of the following mutually exclusive conditions is true: (1) a content of the received message is intended to be read or viewed by a user, and (2) the content of the received message provides instruction codes to an attached printing device

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[2] See, e.g., the '694 patent, column 3, lines 48-54.

associated with the computer, <u>by detecting a predetermined code in a body or a subject line of the message, wherein the instruction to the attached printing device relates to monitoring or control of the attached printing device</u>, as recited in amended Claim 1. The '694 patent is silent regarding the determination recited in Claim 1 being based upon a detecting a predetermined code in a body or a subject line of the message, as recited in Claim 1. Rather, the '694 patent discloses that trigger signals, system alarms, or new e-mail messages need to be redirected, and that e-mail messages may be redirected based upon, for example, who they are from.

The '485 patent is directed to a printer that includes a print controller having memory for storing a plurality of print configuration settings and a processor, and a port coupled to the printer controller that receives signals from a host computer. However, Applicant respectfully submits that the '485 patent fails to remedy the deficiencies of the '694 patent, as discussed above. In particular, the '694 patent fails to disclose, and the Office Action fails to assert that it does disclose, the determining step recited in Claim 1. Applicant respectfully submits that the '485 patent fails to disclose the <u>predetermined code in a body or subject line of a message</u> recited in Claim 1.

Thus, no matter how the teachings of the '694 and '485 patents are combined, the combination does not teach or suggest the step of <u>determining, by a computer, which of the following mutually exclusive conditions is true: (1) a content of the received message is intended to be read or viewed by a user, and (2) the content of the received message provides instruction codes to an attached printing device, associated with the computer, by detecting a predetermined code in a body or a subject line of the message</u>, as recited in amended Claim 1. Accordingly, Applicant respectfully submits that amended Claim 1 (and all similarly rejected dependent claims) is rendered moot by the present amendment to Claim 1.

Independent Claim 23 is directed to a system for processing messages that comprises

means for determining which of the following mutually exclusive conditions is true (1) a

content of the received message is intended to be read or viewed by a user, and (2) the

content of the received message provides instruction codes to an attached printing device

associated with the computer, by detecting a predetermined code in a body or the subject line

of the message. As discussed above, the combined teachings of the '694 and '485 patents fail

to disclose this limitation. Accordingly, Applicant respectfully submits that the rejection of

Claim 23 (and all similarly rejected dependent claims) is rendered moot by the present
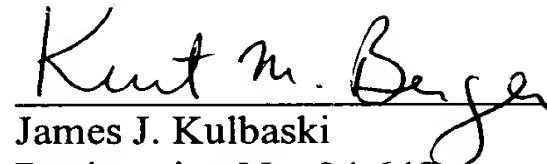
amendment to Claim 23.

Regarding the rejection of dependent Claims 11, 16, 17, 30, 33, 38, 39, and 47 under

35 U.S.C. § 103, Applicant respectfully submits that the '636 and '492, patents fail to remedy

the deficiencies of the '694 and '485 patents, as discussed above. Accordingly, Applicant

respectfully submits that the rejections of the above-noted dependent claims are rendered

moot by the present amendment to Claims 1 and 23.

Thus, it is respectfully submitted that independent Claims 1 and 23 (and all associated

dependent claims) patentably define over any proper combination of the '694, '485, '492 and

'636 patents.

Consequently, in view of the present amendment and in light of the above discussion,

the outstanding grounds for rejection are believed to have been overcome. The application as

amended herewith is believed to be in condition for formal allowance. An early and

favorable action to that effect is respectfully requested.

Respectfully submitted,

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